

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPL. NO : 10/049,256
APPLICANT : GARVEY, Frank Joseph
FILED : May 3, 2002
TITLE : FINGER PROTECTOR DEVICE
TC/A.U. : 3634
EXAMINER : Strimbu, Gregory J.
DOCKET NO. : 148/291

Mail Stop APPEAL BRIEF-PATENTS
Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

Applicant submits the following appeal brief pursuant to 37 C.F.R. § 41.37.

Real party in interest.

Frank J. Garvey is the sole inventor and owner of the subject application.

Related appeals and interferences.

Applicant originally filed an appeal brief in the above-referenced application on November 9, 2004. However, a Notification of Non-Compliant Appeal Brief was mailed by the Patent Office on March 1, 2004. In response, Applicant submitted a second appeal

brief on September 1, 2005 to correct the points of non-compliance cited in the Notification of March 1, 2004. On January 4, 2006, a second Notification of Non-Compliant Appeal Brief was mailed by the Patent Office. On February 6, 2006, Applicant submitted a third appeal brief to correct the points of non-compliance cited in the Notification of January 1, 2005. On April 10, 2006, a third Notification of Non-Compliant Appeal Brief was mailed by the Patent Office. Applicant appreciates the courtesies extended by the Examiner in a telephone interview with the undersigned attorney on April 20, 2006, in which the Examiner provided clarification regarding the points of non-compliance. There are no other prior and pending appeals, interferences or judicial proceedings which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

Status of claims.

Claims 14-19, 22 and 25 are pending in this application and stand rejected. Claims 14, 15, 17-19, 22 and 25 are being appealed. Claims 1-13 were canceled in a preliminary amendment filed with the application. Claims 20, 21, 23 and 24 were canceled without prejudice in an Amendment dated July 22, 2003.

Status of amendments.

Applicant filed an amendment on November 8, 2004. Applicant filed the

amendment for the purpose of cancelling claims, complying with a requirement of form set forth in a previous Office action, and to present rejected claims in better form for consideration on appeal. In an Advisory Action mailed November 19, 2004, the Examiner refused to enter the amendments on the grounds that they raised new issues that would require further consideration and/or search, they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal, and they present additional claims without canceling a corresponding number of finally rejected claims.

Summary of claimed subject matter.

The claimed subject matter is recited in claim 14, which is the only independent claim involved in this appeal, and described in detail in the specification at page 3, line 31 to page 4, line 23, and Figures 1-4. With reference to Figure 1 of the application, the subject matter being claimed is a finger protector device (Fig. 1; Ref. No. 10; page 3, lines 31-32) having a first member (Fig. 1; Ref. No. 16; page 4, line 3), a second member (Fig. 1; Ref. No. 14; page 4, line 4) and a third member (Fig. 1; Ref. No. 12; page 4, line 12), the second member (14) being connected to the first member (16) and third member (12) by flexible sections (Fig. 1; Ref. Nos. 22, 24; page 4, lines 3-5). With reference to Figures 1 and 4, the first member (Fig. 1; Ref. No. 16; page 4, lines 12-14) is arranged, in use, to be mounted to a first surface (Fig. 4; Ref. No. 30; page 4, lines 10-11) by a first mounting portion (Fig. 1; Ref. No. 20; page 4, lines 10-11) connected to the first member (Fig. 1; Ref.

No. 16; page 4, lines 13-14) by a first flexible section (Fig. 1; Ref. No. 28; page 4, line 13) which is pre-biased at about 90° such that the first member (Fig. 1; Ref. No. 16; page 4, line 18) and the first mounting portion (Fig. 1; Ref. No. 20, page 4, lines 17-18) are biased to a relative position of about 90°. The third member (Fig. 1; Ref. No. 12; page 4, line 13) is arranged, in use, to be mounted to a second surface (Fig. 4; Ref. No. 32; page 4, line 11) by a second mounting portion (Fig. 1; Ref. No. 18, page 4, lines 10-14) connected to the third member (Fig. 1; Ref. No. 12, page 4, lines 12-14) by a second flexible section (Fig. 1; Ref. No. 26; page 4, lines 13-14) which is pre-biased at about 90° such that the third member (Fig. 1; Ref. No. 12; page 4, line 18) and the second mounting portion (Fig. 1; Ref. No. 18; page 4, line 17-18) are biased to a relative position of about 90°, in which relative movement of the first surface (Fig. 4; Ref. No. 30; page 4, line 20) and the second surface (Fig. 4; Ref. No. 32; line 21) is possible, and in which each of the mounting portions (Fig. 1; Ref. Nos. 18, 20; page 4, lines 12-13) is attached to a member (Fig. 1; Ref. Nos. 12, 16; page 4, line 13) by flexible plastics (Fig. 1; Ref. Nos. 26, 28; page 4, lines 13-14). The term "flexible means" refers to flexible hinge sections described in page 4, lines 13-14 of the specification and shown at reference numerals 22, 24 in Figure 1.

Grounds of rejection to be reviewed on appeal.

The following rejections are to be reviewed on appeal. In the Office action mailed October 7, 2003, the Examiner rejected all pending claims 14-19, 22 and 25. Claims

14-19, 22 and 25 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 14-19 and 25 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,220,708 to Lucas et al. in view of British Patent Publication No. 2138478. Claim 22 was rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,220,708 to Lucas et al. in view of British Patent Publication No. 2138478 as applied to claims 14-19 and 25 and further in view of Danish Patent Publication No. 9301278. The Examiner's rejections were made final.

Argument.

Rejection based on 35 U.S.C. §112. second paragraph.

The Examiner states that recitations such as "flexible means" on line 3 of claim 14 render the claims indefinite, because the applicant has attempted to use a "means" clause to recite a claim element as a means for performing a specified function, however, no function is specified by the word(s) preceding or following "means." As noted above, applicant has filed, prior to the filing of this brief, an amendment to the claims, which has not yet been entered. In the amendment, the reference to "flexible means" at line 4 of claim 14 has been amended to "flexible sections". In addition, applicant's proposed amendment clarifies which "member" is being referred to throughout claim 14.

The examiner also based the §112 rejection on applicant's use of the term

"pre-biased at about 90°." Applicant respectfully disagrees with the examiner's contention that the term "pre-biased" is confusing and unclear. It is a commonly used technique in plastics manufacturing to provide a bias to a plastics component so that it is not, at rest, in a flat configuration. Thus, it has been "previously-biased" or "pre-biased" to about 90°. It should be noted that Applicant has received examination reports for related applications from the United Kingdom and European Patent Office Examiners, and neither had any objection to this term.

The examiner suggests that the reference to pre-biasing to 90° is unclear because Figure 1 of the application shows the mounting portions at approximately 180° relative to the first and third members respectively. The Examiner has apparently assumed incorrectly that Figure 1 of the subject application shows the device in an "at rest" configuration. In fact, the configuration shown is that adopted when the device is mounted on a closed door as shown in Figure 2. Nevertheless, Applicant's proposed amendment of claim 1 attempts to further clarify what is meant by pre-biased.

Rejections based on 35 U.S.C. §103(a).

The Examiner contends that U.S. Patent No. 5,220,708 to Lucas et al. (hereinafter "Lucas") discloses "a finger protection device 14 comprising first 28, 29, second 27 and third 26 members". However, what the Examiner refers to as a first member in Lucas is in fact two separate members, as shown in Figure 1 and as highlighted by the use of two reference numerals to refer to them. Accordingly, this feature of the claim is not disclosed.

Applicant submits that Lucas does not disclose a first member attached to a mounting portion, a third member attached to a mounting portion, and both being attached to a common second member. Considering Figure 1 of Lucas, there is a first member (26), second member (27), third member (28) and fourth member (29) between the "mounting portions" (25 and 30). The third member (28) of Lucas satisfies the requirement that it be connected to the second member (27), however, it is not attached to a mounting portion (25 or 30). If the members (26-29) are numbered differently, either the same distinction arises, or the first, second and third members are connected/attached to one another. Accordingly, Lucas does not disclose every limitation of claim 14.

Applicant respectfully submits that the Examiner is incorrect in rejecting claim 14 as obvious over Lucas in light of British Patent Publication No. 2,138,478 to Maguire (hereinafter "Maguire"). The Examiner is correct in pointing out that Lucas does not disclose pre-biasing at about 90 degrees. Lucas discloses a self-trimming shield for a door heel, the operation of which is best illustrated in Figures 1 and 2.

Column 2, lines 35-41, of Lucas state that the "joints 52 and 50 are preferably formed with sufficient articulation resistance to provide a constant bias, which urge panels 26 and 27 away from the pinch point formed between door heel 15 and casing joints 16." This is to prevent inversion of the shield during operation. Referring to Figure 1 of Lucas, the joints 52 and 50 are pre-biased so that they tend to force the door open. However, joint 50 is shown at about 90 degrees in Figure 1, implying that it is biased away from this angle in order to exert a force when in this configuration. Thus, to have joint 50 pre-biased to

about 90 degrees, as required by amended claim 1, is contrary to the teaching of Lucas.

Furthermore, with reference to Maguire, there is no disclosure therein that the mounting portions 5 and 6 are pre-biased to about 90 degrees. Figure 1 shows a cross-section of the device, but there is no disclosure that this is the "at rest" configuration thereof. Additionally, there is no teaching in Maguire as to why mounting portions might be pre-biased or what advantage(s) this might provide. Accordingly, there is no teaching discernable to a person skilled in the art as to why such a configuration, which it is denied is disclosed at any rate, would be used elsewhere. The Examiner states that it is common practice to show elements of an invention in an unstressed state. Applicant respectfully submits that it is just as common to show elements of an invention in a stressed state. For instance in Figure 1 of the subject application the device is not shown in its unstressed state. The Examiner's assertion to the contrary is an erroneous assumption. Figure 1 of Maguire has to show the device in a shaped configuration because otherwise it would not be possible to see where the bends in it are. There are no lines showing plastics joints.

Accordingly, Maguire does not teach the pre-bias as claimed in the subject application. Additionally, assuming any such disclosure did exist, which it does not, it would not be consistent with the teaching of Lucas to include such an arrangement therein.

For the reasons stated above, Applicant respectfully submits that claims 14, 15, 17-19, 22 and 25 are in a condition for allowance. The Commissioner is hereby authorized to charge deposit account for fees associated with the filing of this Brief.

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If there are any fees due in connection with this matter, please charge
Applicant's Deposit Account No. 01-0265.

Respectfully submitted,

/Stephen S. Ashley, Jr./

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*Claims Appendix
for Appeal Brief in Application No. 10/049,256*

Claim 14: A finger protector device comprising first, second and third members, the second member being connected to the first and third members by flexible means, the first member is arranged, in use, to be mounted to a first surface by a first mounting portion connected to the first member by a first flexible section and the third member is arranged, in use, to be mounted to a second surface by a second mounting portion connected to the third member by a second flexible section, in which relative movement of the first and second surfaces is possible and in which each of said mounting portions is attached to a member by a flexible plastics joint, which is pre-biased at about 90° relative to the member to which it is attached.

Claim 15: A finger protector device according to claim 14, in which the flexible sections provide a pivotal connection.

Claim 17: A finger protector device according to claim 14, in which the first surface is a door.

Claim 18: A finger protector device according to claim 14, in which the second surface is a door frame.

Claim 19: A finger protector device according to claim 14, in which the first, second and third members are elongate members.

Claim 22: A finger protector device according to Claim 14, in which each of said mounting portions is thicker than the first, second and third members.

Claim 25: A finger protector device according to claim 14, in which the door frame is connected to the first mounting portion which is pivotally connected to the first member which is pivotally connected to the second member which is pivotally connected to the third member which is pivotally connected to the second mounting portion which is connected to a door, and wherein the first, second and third members and the first and second mounting portions are all elongate members, and further wherein the finger protector device has a substantially uniform cross-section along its length.

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*Evidence Appendix
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No evidence has been submitted in this case.

*Related Proceedings Appendix
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There have been no decisions rendered in any related proceedings.